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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/783,909 | 02/20/2004 | Michael McDonald | DNCEH-66401 | 7143 |
| 24201 7590 03/17/2008 FULWIDER PATTON LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE, TENTH FLOOR LOS ANGELES, CA 90045 | | | | |
| EXAMINER | | | | |
| FRISBY, KESHA | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3714 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 03/17/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/783,909

Applicant(s)

MCDONALD ET AL.

Examiner

KESHA FRISBY

Art Unit

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 16, 18, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 16, 18, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

After the amendment filed on 1/9/2008, claims 3, 16, 18, 22 & 23 are pending.

Claims 1, 2, 4-15, 17 & 19-21 are cancelled.

Allowable Subject Matter

1. The indicated allowability of claims 3, 16, 18, 22 & 23 are withdrawn in view of the newly discovered reference(s) to Corset (U.S. Publication Number 2002/0007718) and the "Obvious to Try" Rationale (MPEP 2141). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

2. Claim 3 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure fails to specify physically restraining the positioning if the at least one dancer's head "only in a lateral direction" so that the at least one dancer's head remains substantially in a fixed position "only laterally" during the video showing the performance of the dance routine by the dancer. The phrases in the quotations are being considered new matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toniolo (U.S. Publication Number 2006/0154220) in view of Rosedale (U.S. Patent Number 7,117,1136), Carnival Parties 5yr (NPL) and Parulski et al. (U.S. Patent Number 5,595,389).

Referring to claim 3, Toniolo discloses providing a dance routine with music, involving at least one dancer (paragraph 0011), providing a video of the dance routine, with the music, showing the dancer's body but not the dancer's head (easily adjust the camera angle to suit a particular application), and the movement of the dancer's body in synchronism with the music (Fig. 13 & the associated text: paragraphs 0104-0106), recording the video appearance of the at least one celebrant's head during the playing of the music to the at least one celebrant (paragraph 0106: easily adjust the camera angle to suit a particular application). *Toniolo does not teach with the head in a substantially stationary disposition, disposing the head of at least one celebrant in an opening in a foreground enclosure disposed in front of the celebrant's head, recording the head in the opening and replacing the at least one celebrant's head in place of the at least one dancer's head at the position of the at least one dancer's head in the video of the at least one dance routine to provide a video of the dancer's body and the at least one celebrant's head and physically restraining the positioning of the at least one dancer's head only in a lateral direction so that the at least one dancer's head remains substantially in a fixed only laterally during the video showing the performance of the*

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dance routine by the dancer. Rosedale teaches with the head in a substantially stationary disposition (Figs. 1A, 4A, 4B & the associated text) and physically restraining the positioning of the at least one head only in a lateral direction so that the at least one head remains substantially in a fixed only laterally during the video showing the performance of the dance routine by the dancer (Figs. 1A, 4A, 4B & the associated text). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the head in a substantially stationary disposition, as disclosed by Rosedale, incorporated into Toniolo in order to allow input and feedback based on various parts of the user's body. In addition, it would have been obvious to a person of ordinary skill in the art to hold the head in a lateral direction, as taught by Rosedale, in an attempt to have little or predictable movement. As a result, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. In turn, because restraining the head in only a lateral direction as claimed has properties predicted by the prior art, it would have been obvious to have the head restrained in only the lateral direction in order to morph the head and body together via reference points with very little offset. Further, the fact that a combination was obvious to try might show it was obvious under U.S.C. 103. KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1386 (2007). *Toniolo/Rosedale does not teach disposing the head of at least one celebrant in an opening in a foreground enclosure disposed in front of the celebrant's head and replacing the at least one celebrant's head in place of the at least one dancer's head at the position of the at least one dancer's head in the video of the at least one dance routine to provide a video of the dancer's*

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body and the at least one celebrant's head. Carnival Parties 5yr teaches disposing the head of at least one celebrant in an opening in a foreground enclosure disposed in front of the celebrant's head (page 3) and recording the head in the opening (page 3: photograph taken). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include disposing the head of at least one celebrant in an opening in a foreground enclosure disposed in front of the celebrant's head, as disclosed by Carnival Parties 5yr, incorporated into Toniolo/Rosedale in order to give the image a different look. *Toniolo/Rosedale/Carnival Parties 5yr does not teach replacing the at least one celebrant's head in place of the at least one dancer's head at the position of the at least one dancer's head in the video of the at least one dance routine to provide a video of the dancer's body and the at least one celebrant's head and providing a video of the dance routine to the celebrant with the at least on celebrant's head replacing the at least one dancer's head.* However, Parulski et al. teaches replacing the at least one celebrant's head in place of the at least one dancer's head at the position of the at least one dancer's head in the video of the at least one dance routine to provide a video of the dancer's body and the at least one celebrant's head (Figs. 1 & 2B & the associated text). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replacing heads, as disclosed by Parulski et al., incorporated into Toniolo/Rosedale/Carnival Parties 5yr so that the celebrant can view themselves performing the recorded dance moves.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al. in view of Rosedale and Corset (U.S. Publication Number 2002/007718).

Referring to claim 16, Parulski et al. discloses providing a video image and a synchronized audio recording on a medium capable of being duplicated (column 1 lines 55-58), the visual image and the audio recording being of a dancer providing a dance routine, removing the dancer's head from the video image (Figs. 1, 2A, 2B and the associated text), and substituting a celebrant's head on the dancer's body after removing the dancer's head from the dancer's body in the video (Figs. 1, 2A, 2B and the associated text) and processing the disposition and appearance of the celebrant's head on the dancer's body to assure that the celebrant's head is disposed on the dancer's neck (Figs. 1, 2A, 2B and the associated text). *Parulski does not disclose a dancer and where the head is in a substantially stationary lateral disposition and restraining only the dancer's head to a substantially unitary lateral position while the dancer is performing the dance routine in synchronism with the music and providing the image of the celebrant in a foreground of a particular color so that only the celebrant's head is visible in the foreground of the particular color, and eliminating the foreground of the particular color from the image of the celebrant's head before the image of the celebrant's head is transferred to the dancer's body in replacement of the dancer's head.* However, Rosedale teaches where the head is in a substantially stationary lateral disposition (Figs. 1A, 4A, 4B & the associated text).

Rosedale does not disclose expressly restraining only the head to a substantially unitary lateral position. Instead, Rosedale indicates restraining multiple limbs (abstract).

At the time the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to restrain only the head to a substantially unitary lateral position because Applicant has not disclosed that to a substantially unitary lateral position provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Rosedale's system, and applicant's invention, to perform equally well with either restraining multiple limbs taught by Rosedale or the claimed restrain only the head to a substantially unitary lateral position because both restraining systems would perform the same function of restraining limbs.

Therefore, it would have been prima facie obvious to modify Rosedale to obtain the invention as specified in claim 16 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Rosedale.

Parulski et al./Rosedale does not disclose a dancer and providing the image of the celebrant in a foreground of a particular color so that only the celebrant's head is visible in the foreground of the particular color, and eliminating the foreground of the particular color from the image of the celebrant's head before the image of the celebrant's head is transferred to the dancer's body in replacement of the dancer's head. However, Corset teaches a dancer (paragraph 0005) providing the image of the celebrant in a foreground of a particular color so that only the celebrant's head is visible

in the foreground of the particular color (paragraphs 0010 & 0011), and eliminating the foreground of the particular color from the image of the celebrant's head before the image of the celebrant's head is transferred to the dancer's body in replacement of the dancer's head (paragraphs 0010 & 0011). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include providing the image in a foreground and eliminating the foreground, as disclosed by Corset, incorporated into Parulski et al./Rosedale in order to replace and morph the heads on each body.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al. in view of Rosedale and Corset.

7. Referring to claim 18, Parulski et al. discloses providing a video image and a synchronized audio recording on a medium capable of being duplicated (column 1 lines 55-58), the visual image and the audio recording being of a dancer providing a dance routine, removing the dancer's head from the video image (Figs. 1, 2A, 2B and the associated text), and substituting a celebrant's head on the dancer's body after removing the dancer's head from the dancer's body in the video (Figs. 1, 2A, 2B and the associated text) and processing the disposition and appearance of the celebrant's head on the dancer's body to assure that the celebrant's head is disposed on the dancer's neck (Figs. 1, 2A, 2B and the associated text). *Parulski does not disclose a dancer and where the head is in a substantially stationary lateral disposition, providing the image of the celebrant in a foreground of a particular color so that only the celebrant's head is visible in the foreground of the particular color, and eliminating the foreground of the*

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particular color from the image of the celebrant's head before the image of the celebrant's head is transferred to the dancer's body in replacement of the dancer's head. However, Rosedale teaches where the head is in a substantially stationary lateral disposition (Figs. 1A, 4A, 4B & the associated text). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include where the head is in a substantially stationary lateral disposition, as disclosed by Rosedale, incorporated into Parulski et al. in order to allow input and feedback based on various parts of the user's body. *Parulski et al./Rosedale does not disclose a dancer and providing the image of the celebrant in a foreground of a particular color so that only the celebrant's head is visible in the foreground of the particular color, and eliminating the foreground of the particular color from the image of the celebrant's head before the image of the celebrant's head is transferred to the dancer's body in replacement of the dancer's head.* However, Corset teaches a dancer (paragraph 0005) and providing the image of the celebrant in a foreground of a particular color so that only the celebrant's head is visible in the foreground of the particular color (paragraphs 0010 & 0011), and eliminating the foreground of the particular color from the image of the celebrant's head before the image of the celebrant's head is transferred to the dancer's body in replacement of the dancer's head (paragraphs 0010 & 0011). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include providing the image in a foreground and eliminating the foreground, as disclosed by Corset, incorporated into Parulski et al./Rosedale in order to replace and morph the heads on each body.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al./Rosedale/Corset and further in view of Korn (U.S. Patent Number 5,781,198).

Referring to claim 22, Parulski et al./Rosedale/Corset discloses a method as set forth in claim 16. *Parulski et al./Rosedale/Corset does not disclose including the steps of: providing the image of the celebrant's head in a background of a particular color so that only the celebrant's head is visible in the background of the particular color, and eliminating the background of the particular color from the image of the celebrant's head before the image of the celebrant's head is transferred to the dancer's body in replacement of the dancer's head and disclose providing the image of the celebrant in a foreground of a particular color so that only the celebrant's head is visible in the foreground of the particular color, and eliminating the background of the particular color from the image of the celebrant's head before the image of the celebrant's head is transferred to the dancer's body in replacement of the dancer's head.* However, Korn teaches including the steps of: providing the image of the celebrant's head in a background of a particular color so that only the celebrant's head is visible in the background of the particular color (Figs. 4B & 4D & the associated text), and eliminating the background of the particular color from the image of the celebrant's head before the image of the celebrant's head is transferred to the dancer's body in replacement of the dancer's head (column 3 lines 11-15) and providing an individualized background after the removal of the background of the particular color (column 7 lines 17-32) and providing the image of the celebrant in a foreground of a particular color so that only the

celebrant's head is visible in the foreground of the particular color (Figs. 4B & 4D & the associated text), and eliminating the background of the particular color from the image of the celebrant's head before the image of the celebrant's head is transferred to the dancer's body in replacement of the dancer's head (column 3 lines 11-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include providing the image of the celebrant's head in a background of a particular color and eliminating the background of the particular color, as disclosed by Korn, incorporated into Parulski et al./Rosedale/Corset in order to allow for real time background replacement.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al./Rosedale/Corset/Korn and further in view of Stamper et al. (U.S. Patent Number 6,894,686) and Horigami et al. (U.S. Patent Number 6,758,756).

8. Referring to claim 23, Parulski et al./Rosedale/Corset/Korn discloses a method as set forth in claim 22 and including the steps of: and providing an individualized background after the removal of the background of the particular color (column 7 lines 17-32 of Korn). *Parulski et al./Rosedale/Corset/Korn does not disclose enlarging the celebrant's head relative to the dancer's head in the video image to insure that the head is disposed on the dancer's neck regardless of a slight displacement of the dancer's body from a particular position and including the step of: employing digitizing techniques to adjust for changes in the position of the dancer's body, thereby to align the dancer's body with the celebrant's head.* However, Stamper et al. teaches enlarging the celebrant's head relative to the dancer's head in the video image to insure that the head

is disposed on the dancer's neck regardless of a slight displacement of the dancer's body from a particular position (column 2 lines 57-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include enlarging, as disclosed by Stamper et al., incorporated into Parulski et al./Rosedale/Corset/Korn in order to manipulate images. *Parulski et al./Rosedale/Corset/Korn /Stamper et al. does not disclose including the step of: employing digitizing techniques to adjust for changes in the position of the dancer's body, thereby to align the dancer's body with the celebrant's head.* However, Horigami et al. teaches including the step of: employing digitizing techniques to adjust for changes in the position of the dancer's body, thereby to align the dancer's body with the celebrant's head (column 11 lines 26-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include digitizing the recorded video, as disclosed by Horigami et al., incorporated into Parulski et al./Rosedale/Corset/Korn/Stamper et al. so that the video will look as real as possible.

Response to Arguments

9. Applicant's arguments with respect to claims 3, 16, 18, 22 & 23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KESHA FRISBY whose telephone number is (571)272-8774. The examiner can normally be reached on Monday-Friday 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. F./
Examiner, Art Unit 3714

/Ronald Laneau/
Supervisory Patent Examiner, Art Unit 3714
03/07/08